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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/455,805	12/07/1999	SUSAN D. WOOLF	03797.78802	5591
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BANNER & WITCOFF LTD., ATTORNEYS FOR MICROSOFT 1001 G STREET, N.W. ELEVENTH STREET WASHINGTON, DC 20001-4597			EXAMINER NGUYEN, MAIKHANH	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/455,805

Applicant(s)

WOOLF ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/21/05 & 10/6/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 08/11/2005 to the original application filed 12/07/1999; IDS filed 09/21/2005 and 10/06/2005.
2. Claims 1-29 are currently pending in this application. Claims 1, 10, 16, and 29 are independent claims.

Response to Arguments

3. Applicant's arguments filed 08/11/2005 have been fully considered but they are not persuasive.

Applicants submitted the declaration under 37 CFR 1.131 to swear behind the Eintracht reference. However, the declaration is not sufficient to overcome the Eintracht reference for the reasons below in the Response to Affidavit.

Response to Affidavit 37 CFR 1.131

4. The Declaration filed on August 11, 2005 has been considered but is ineffective to overcome the effective filing date of the Eintracht reference (U.S. 6,687,878 - filing date March 15, 1999).
 - a. The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country after the effective date of the Eintracht reference.

Art Unit: 2176

- b. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Eintracht reference.

"Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897), it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also." (see MPEP 715.07).

"A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883). Similarly, a declaration by the inventor to the effect that his or her invention was conceived or reduced to practice prior to the reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131." (See MPEP 715.07).

"The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")" (See MPEP 715.07).

- c. In the declaration, Applicants do not specifically point out the claimed invention and has not given a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by Applicants. A generation allegation that the invention was completed prior to the effect that his or her invention was conceived or reduced to practice prior to the

Art Unit: 2176

reference date, without a statement of facts demonstrating the correctness of this conclusion, is insufficient to satisfy 37 CFR 1.131.

- d. On page 3 of the declaration, Applicants allegedly declare that the “screenshot” of Exhibit A is an evidence for conception and the actual reduction to practice prior to March 15, 1999 and supports claims 1-29 of the present patent application. However, Applicant statements are not sufficient proof or does not show sufficient facts describing the “screenshot” of Exhibit A of how it existed and what they are or when they occur prior to March 15, 1999 to properly demonstrate the reduction to practice. Furthermore, Applicants have fail to provide a clear explanation of how the claimed invention equates with the “screenshot” of Exhibit A to disclose the conception of the invention as claimed.

*In general, proof of actual reduction to practice requires a showing that the apparatus actually existed and worked for its intended purpose. However, “there are some devices so simple that a mere construction of them is all that is necessary to constitute reduction to practice.” In re Asahi/America Inc., **>68 F.3d 442, 37 USPQ2d 1204, 1206< (Fed. Cir. 1995) (Citing Newkirk v. *>Lulejian<, 825 F.2d 1581, 3USPQ2d 1793 (Fed. Cir.1987) and Sachs v. Wadsworth, 48 F.2d 928, 929, 9 USPQ 252, 253 (CCPA 1931). The claimed restraint coupling held to be so simple a device that mere construction of it was sufficient to constitute reduction to practice. Photographs, coupled with articles and a technical report describing the coupling in detail were sufficient to show reduction to practice.) (MPEP 715.07- III)*

“For an actual reduction to practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but it need not be

Art Unit: 2176

in a commercially satisfactory stage of development. If a device is so simple, and its purpose and efficacy so obvious, construction alone is sufficiently to demonstrate workability. King Instrument Corp. v. Otari Corp., 767 F.2d 853, 860, 226 USPQ 402,407 (Fed. Cir. 1985). For additional cases pertaining to the requirements necessary to establish actual reduction to practice see DSL Dynamic Sciences, Ltd. v. Union Switch & Signal, Inc., 928 F.2d 1122, 1126, 18 USPQ2d 1152, 1155 (Fed. Cir. 1991) ("events occurring after an alleged actual reduction to practice can call into question whether reduction to practice has in fact occurred"); Corona M. Dovan, 273 U.S. 692, 1928 C.D. 252 (1928) ("A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed." 1928 C.D. at 262-263 (emphasis added).); Fitzgerald v. Arbib, 268 F.2d 763, 765-66, 122 USPQ 530, 531-32 (CCPA 1959) ("the reduction to practice of a three-dimensional design invention requires the production of an article embodying that design" in "other than a mere drawing")" (MPEP 2138.05).

- e. On the declaration, Applicants allegedly declare that the "screenshots" of Exhibits D and F as evidences for reduction to practice. Applicant's screenshots do not show connection between the claim language and Exhibits D and F, nor does not describe the invention that is tested, or indication that it was testing. Accordingly, this is not properly of evidence that show the invention worked or was tested.

Art Unit: 2176

In view of the lack of presented exhibits of support as explained above, the presented affidavit is insufficient proof that Applicant's invention was conceived and reduced to practice before the filing date of the Eintracht reference. Accordingly, Applicants have not established prior invention. The rejection is maintained.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 5-10, 13-16, and 19-28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** (U.S. 5,680,636, issued 10/1997, as cited by Applicant's IDS filed 11/26/2003) in view of **Eintracht et al.** (U.S. 6,687,878 – filed 03/1999).

As to independent claim 16:

- a. Levine teaches a computer-readable storage medium comprising computer-executable instruction for performing steps comprising:

- (i) displaying an electronic document page on a computer display device permitting a user to move forward and backward among a plurality of document pages (*e.g., the display screen and/or have several pages ... scrolling from top to bottom of a single page or sequentially from one page to succeeding or preceding pages; col.20, lines 44-48*); and
 - (ii) annotating parts of a currently displayed page in accordance with movement of a user input device to indicate where on the currently displayed document page the annotations should appear (*e.g., the user simply places one end of the stylus on the table position which corresponds to the position of the typing cursor in the displayed view of the document being annotated and move the stylus end across the surface of the tablet to the desired position; col.4, lines 18-39*).
- b. Levine, however, does not specifically teach “storing annotations separate from the electronic document.”
- c. Eintracht teaches storing annotations separate from the electronic document (*e.g., store the documents in the document file separately from notes stored in the notes database; col.3, lines 12-36*).
- d. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Eintracht in the system of Levine because it would have allowed multiparty collaboration based on the asynchronous exchange of annotations over a network such as the Internet without the requirement that all parties wishing to collaborate be simultaneously logged on to a server.

Art Unit: 2176

As to dependent claim 19:

It includes the same limitations as in claim 5 above, and is similarly rejected under the same rationale.

As to dependent claim 20:

Levine teaches in response to detecting that the user has moved to a different document page (*col.19, lines 23-38*), retrieving previously stored annotations associated with the different document page; and displaying the annotations retrieved in step (a) on the different document page (*col.20, lines 18-57*).

As to dependent claim 27:

Levine teaches annotations are stored in a data structure as strokes (*col.6, lines 29-38*).

As to dependent claim 28:

Levine teaches annotations are stored as a bitmap image (*e.g., An annotatable bitmap image; Abstract*).

As to independent claim 10:

Note the rejection of claim 16 above. Claim 10 includes the same limitations as in claim 16, except claim 16 is a computer-readable storage medium claim and claim 10 is a method claim.

As to dependent claim 13:

Levine teaches the computer software displays and stores erased annotations that remove previously made annotations on the currently displayed document page (*e.g., the area on the document which has presently been erased by the stylus is restored; col.5, lines 51-55*).

Art Unit: 2176

As to dependent claim 14:

Levine teaches a flat panel display, and wherein the computer input device comprises a stylus (*col.6, lines 30-50*).

As to dependent claim 15:

Levine teaches upon detecting a title change event, previously stored annotations associated with a different document page (*col.19, lines 58-col.20, line 11*) and displays the previously stored annotations on the different document page (*col.20, lines 18-57*).

As to dependent claim 24:

Levine teaches annotation mode selection menu (*col.5, lines 8-45*).

As to dependent claim 25-26:

They include the same limitations as in claims 27-28, and are similarly rejected under the same rationale.

As to independent claim 1:

The rejection of independent claim 16 above is fully incorporated herein.

Additionally, Levine further teaches selecting an annotation mode that permits the user to annotate the currently displayed document page (*e.g., annotated by the user selecting a "note pad" option displayed in the desk view; col.4, lines 4-17*).

As to dependent claim 5:

Levine teaches instructions for erasing portions of previously created annotations (*col.6, lines 1-10*).

As to dependent claim 6:

Art Unit: 2176

Levine teaches the step of using a stylus with a tablet computer system (*e.g., the electronic stylus and tablet; col.1, lines 52-60*).

As to dependent claim 7:

Levine teaches the step of storing a separate stroke for each annotation, wherein each stroke corresponds to a continuous set of movement when the user input device is activated (*col.6, lines 51-56*).

As to dependent claim 8:

Levine teaches moving to a different document page (*col.20, lines 44-57*); retrieving previously stored annotations associated with the different document page; and displaying the retrieved annotations on the computer display device superimposed over the different document page (*see the Abstract*).

As to dependent claim 9:

Levine teaches the step of detecting a title change event in the document browser and, in response thereto, locating an annotation file corresponding to the different document page (*col.19, line 58-col.20, line 11*).

As to dependent claim 21:

Levine teaches annotations are stored in a data structure as strokes (*col.2, lines 33-36 & col.6, lines 29-56*).

As to dependent claim 22:

Levine teaches each stroke includes a stroke width and coordinates indicating a trajectory of the stroke (*col.6, lines 30-50*).

As to dependent claim 23:

Art Unit: 2176

It includes the same limitations as in claim 28, and is similarly rejected under the same rationale.

7. Claims 2-4, 11-12, 17-18 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over **Levine et al.** in view of **Eintracht** as applied to claims 1, 10 and 16 above, and further in view of **Alexander** (U.S. 6,320,577 –filed 11/1998).

4.

As to dependent claim 2:

- a. The combination of Levine and Eintracht does not specifically teach “*using opaque markings that obscure portions of the currently displayed document page.*”
- b. Alexander teaches using opaque markings that obscure portions of the currently displayed document page (*col.23, lines 5-12*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander’s teachings in the system of Levine as modified by Eintracht because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to dependent claim 3:

- a. The combination of Levine and Eintracht does not specifically teach “*using a translucent highlighting that does not completely obscure the annotated portions of the currently displayed document page.*”

Art Unit: 2176

- b. Alexander teaches using a translucent highlighting that does not completely obscure the annotated portions of the currently displayed document page (*col.23, lines 5-12*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Eintracht because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to dependent claim 4:

- a. The combination of Levine and Eintracht does not specifically teach *"blending pixels from the currently displayed document with a translucent color to produce a translucent annotation."*
- b. Alexander teaches blending pixels from the currently displayed document with a translucent color to produce a translucent annotation (*col.23, lines 13-28*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Eintracht because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

As to dependent claims 11-12:

They include the same limitations as in claims 2-3 above, and are similarly rejected under the same rationale.

Art Unit: 2176

As to dependent claim 17:

It includes the same limitations as in claim 2 above, and is similarly rejected under the same rationale.

As to dependent claim 18:

It includes the same limitations as in claims 3-4 above, and is similarly rejected under the same rationale.

As to independent claim 29:

- a. The rejection of independent claim 16 above is fully incorporated herein.
Additionally, Levine further teaches:
 - (i) determining an initial position of the annotation (*col.4, lines 18-39*);
 - (ii) determining a width and trajectory of the annotation (*col.6, lines 30-5*); and
 - (iii) receiving a signal representing that the annotation is complete (*col.6, lines 19-28*).
- b. The combination of Levine and Eintracht does teach displaying the annotation that is superimposed over on the document page (*annotations are superimposed on a displayed, annotatable image; Abstract*). The combination, however, does not specifically teach “displaying the annotation in an ink layer that is blended with pixels on the document page.”
- c. Alexander teaches displaying the annotation in an ink layer that is blended with pixels on the document page (*col.22, line 60-col.23, line 13*).

Art Unit: 2176

- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Alexander's teachings in the system of Levine as modified by Eintracht because it would have provided the capability for convenient adjusting the location of the annotation label as well as the appearance of the annotation label on the display.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are

Art Unit: 2176

unsuccessful, the examiner's supervisor, Heather Herndon can be reached on
(571) 272-4136.

The fax phone number for the organization where this application or proceeding is
assigned is 571-273-8300.

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MN

William L. Bashore
WILLIAM BASHORE
PRIMARY EXAMINER
10/26/2005